

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-17 are pending in the application, with claims 1, 7, 9, 15, and 16 as being the independent claims. No claims are sought to be cancelled without prejudice to or disclaimer of the subject matter therein. No new claims are sought to be added. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding rejections and that they be withdrawn.

Rejections under 35 U.S.C. § 102

Claims 1-17 have been rejected under 35 U.S.C. 102(e) as being anticipated by Published U.S. Patent Application No: 2001/0054074, entitled *Electronic Mail System and Device*, filed by Kiyoko Hayashi on March 8, 2001 ("Hayashi Patent Application"). Applicants respectfully traverse this rejection. Based on the remarks set forth below, Applicants respectfully request that this rejection be reconsidered and withdrawn.

Applicants do not acquiesce that the priority date of the Hayashi Patent Application precedes the date of invention of the present invention. Applicants reserve the right to establish that the Hayashi Patent Application may not be prior art, and/or to prove that the Hayashi Patent Application may not be enabling for the teachings purportedly offered. Assuming arguendo that the Hayashi Patent Application is prior art,

Applicants provide the following arguments that demonstrate that the examiner's rejections should be withdrawn.

Claim 1 of the present application include the elements of storing on a mass storage device said media component of said message and storing on an email server said non-media component of said message and a corresponding reference to said stored media component of said message. The Hayashi Patent Application does not disclose storing the media component and the non-media component on separate storage devices or servers. In fact, the Hayashi Patent Application explicitly refers to storing the media component and non-media components on a single device. Specifically, the Hayashi Patent Application states that "[a] further object of the present invention is to provide an electronic mail device comprising a memory for storing an electronic mail data and attached file data." Hayashi Patent Application at ¶ 0009 (emphasis added).

Furthermore, Claim 1 of the Hayashi Patent Application claims [a]n electronic mail device for an electronic mail text with an attachment file attached thereto, comprising: a memory for storing the electronic mail text and attachment file." *Id.* at claim 1 (emphasis added). The Hayashi Patent Application consistently refers to the use of a single memory for storing both the electronic mail and attachment file. Thus, the Hayashi Patent Application fails to disclose at least the elements contained in claim 1 of the present application of storing on a mass storage device said media component of said message and storing on an email server said non-media component of said message and a corresponding reference to said stored media component of said message. Moreover, by referring to using a single memory for storage, the Hayashi Patent Application teaches away from the present invention. The use of a single storage device for storing email

messages and attachments is disclosed as one of the problems that the present application may solve in the background section of the present application in paragraph 4.

As such, the Hayashi Patent Application does not disclose, suggest, or teach each and every element of claim 1, as amended herein. A claim is anticipated only if each and every element set forth in the claim is found in a single prior art reference. MPEP § 2131. Thus, at least for the reason stated above, claim 1, as amended herein, is patentable over the Hayashi Patent Application. Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 1.

Claims 2-6 depend upon claim 1. Because each dependent claim incorporates all of the elements of the independent claim from which it depends, as well as additional features, the above arguments made with respect to claim 1, apply *a fortiori* to the dependent claims. Thus, claims 2-6 are also patentable over the Hayashi Patent Application.

Claim 7 of the present application includes the elements of a mass storage device for storing the media component of a message and a storage device, coupled to an email server, that stores the non-media component of said message and a corresponding reference to the media component of said message. As discussed above, the Hayashi Patent Application discloses only the use of a single memory for storage of both the media and non-media components.

As such, the Hayashi Patent Application does not disclose, suggest, or teach each and every element of claim 7, as amended herein. A claim is anticipated only if each and every element set forth in the claim is found in a single prior art reference. MPEP § 2131. Thus, at least for the reason stated above, claim 7, as amended herein, is

patentable over the Hayashi Patent Application. Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 7.

Claim 8 depends upon claim 7. Because each dependent claim incorporates all of the elements of the independent claim from which it depends, as well as additional features, the above arguments made with respect to claim 7, apply *a fortiori* to the dependent claims. Thus, claim 8 is also patentable over the Hayashi Patent Application.

Claim 9 of the present application includes the elements of a second computer readable program codes means for causing the computer to store on a mass storage device said media component of said message and a third computer readable program codes means for causing the computer to store on an email server the non-media component of said message and a corresponding reference to the media component of said message. As discussed above, the Hayashi Patent Application discloses only the use of a single memory for storage of both the media and non-media components.

As such, the Hayashi Patent Application does not disclose, suggest, or teach each and every element of claim 9, as amended herein. A claim is anticipated only if each and every element set forth in the claim is found in a single prior art reference. MPEP § 2131. Thus, at least for the reason stated above, claim 9, as amended herein, is patentable over the Hayashi Patent Application. Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 9.

Claims 10-14 depend upon claim 9. Because each dependent claim incorporates all of the elements of the independent claim from which it depends, as well as additional features, the above arguments made with respect to claim 9, apply *a fortiori* to the

dependent claims. Thus, claims 10-14 are also patentable over the Hayashi Patent Application.

Claim 15 of the present application includes the elements of storing media components of the messages at a first location and storing references to the stored media components of the messages and remaining portions of the messages without the media components at a second location. As discussed above, the Hayashi Patent Application discloses only the use of a single memory for storage of both the media and non-media components.

As such, the Hayashi Patent Application does not disclose, suggest, or teach each and every element of claim 15, as amended herein. A claim is anticipated only if each and every element set forth in the claim is found in a single prior art reference. MPEP § 2131. Thus, at least for the reason stated above, claim 15, as amended herein, is patentable over the Hayashi Patent Application. Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 15.

Claim 16 depends upon claim 15. Because each dependent claim incorporates all of the elements of the independent claim from which it depends, as well as additional features, the above arguments made with respect to claim 15, apply *a fortiori* to the dependent claims. Thus, claim 16 is also patentable over the Hayashi Patent Application.

Claim 17 of the present application includes the elements of a first storage device that stores media components of messages and a second storage device that stores references to the stored media components of the messages and remaining portions of the

messages without the media components. As discussed above, the Hayashi Patent Application discloses only the use of a single memory for storage of both the media and non-media components.

As such, the Hayashi Patent Application does not disclose, suggest, or teach each and every element of claim 17, as amended herein. A claim is anticipated only if each and every element set forth in the claim is found in a single prior art reference. MPEP § 2131. Thus, at least for the reason stated above, claim 17, as amended herein, is patentable over the Hayashi Patent Application. Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 17.

In the rejection of claims 1-17, the Examiner further states that the claims "were not distinct from convention electronic mail and attachment, which were used to send media object separately from the e-mail in order to minimize network bandwidth utilization." Office Action at p. 2. As a threshold matter, the general statements by the examiner do not support the needing showing that existing systems teach or suggest each and every element of the claims. Furthermore, the present application focuses on the storage of email messages and attached files, thus applicants fail to see the relevancy of the Examiner's statement. The Examiner appears to be making an inherency argument relative to email systems that may send email messages and attachments separately. Applicants do not acquiesce as to whether such systems actually exist. Assuming *arguendo* that they did exist at the date of invention, the fact that a certain result or characteristics may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. MPEP 2112 *citing In re*

Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). In relying upon a theory of inherency as the Examiner appears to have done above, an examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied art. MPEP 2112. Applicants respectfully contend that the Examiner has not met this burden, and request that the Examiner provide technical reasoning or facts to support the above proposition, or withdraw the assertion and associated rejections.

For at least the reasons stated above, Applicants respectfully request that the Examiner reconsider the rejections of claims 1-17, and that these claims be found allowable.

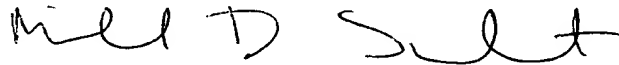
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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